

### REMARKS

Applicant respectfully requests reconsideration and allowance in view of the foregoing amendments and following remarks. In the Office Action, mailed September 24, 2002, the Examiner rejected claims 1-7, 10-14, 23, 24 and 26. By this amendment, claims 1 and 10 have been amended. Following entry of these amendments, claims 1-7, 10-14, 23, 24 and 26 will be pending in the application.

#### ***Claim Rejections under 35 U.S.C. §102(e)***

In the Office Action, the Examiner rejected claims 1-6, 10-13, 23 and 26 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 5,963,916 to Kaplan ("Kaplan"). Applicant has amended claims 1 and 10 to further clarify the invention. Thus, Applicant respectfully traverses the rejections of claims 1-6, 10-13, 23 and 26.

An anticipation rejection is proper only when a patent applicant has claimed an invention that "was described in ... a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." 35 U.S.C. §102(e). A claim is anticipated under 35 U.S.C. §102(e) "only if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (emphasis in original), *cert. denied*, 488 U.S. 892 (1988). "To establish inherency, the extrinsic evidence, 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). Upon reliance on a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

For at least the reasons stated below, Applicant asserts that Kaplan fails to expressly or inherently describe each and every element of the invention claimed by Applicant and, therefore, that Applicant's rejected claims 1-6, 10-13, 23 and 26 are patentably distinct from Kaplan.

P

Applicant's independent claim 1, as amended, recites a method of disseminating information over a private network concerning a product that includes:

- providing one or more databases that receive content providers' files, said databases including digitized and cataloged product information and at least one of sponsor information and attract videos;

- creating designated files for distribution to one or more end clients by combining into a single file said content providers' files, including said digitized and cataloged product information and said at least one of sponsor information and attract videos, and at least one attribute assigned for each content provider file;

- transmitting said designated files to said end clients remotely disposed with respect to said one or more databases, wherein each end client receives only its designated files;

- providing a perceivable stimulus, from said designated files to said consumer, said perceivable stimulus being associated with said product; and

- wherein an interactive consumer stimulus initiated by the consumer includes said perceivable stimulus.

Kaplan neither discloses nor suggests a method of disseminating information over a private network concerning a product as recited, having databases that receive content providers' files including digitized and cataloged product information and at least one of sponsor information and attract videos, and designated files created that include at least one attribute assigned for each content provider file as required by amended independent claim 1.

In asserting anticipation of the invention as claimed in independent claim 1, the Examiner refers to Figures 2 and 35-57 of Kaplan. Figure 2 of Kaplan illustrates the delivery of an audio or video sample over the Internet using Point-of-Preview and Point-of-Sale stations that receive the audio or video samples from compact discs over the Internet. Figures 35-57 illustrate Internet browser screen-shots of the system shown in Figure 2. Kaplan does not disclose or suggest the subject matter of amended independent claim 1 for at least the following reasons.

First, Kaplan nowhere discloses a method of disseminating information over a private network as required by amended independent claim 1. Rather, Kaplan discloses providing music samples over the publicly accessible Internet. The Kaplan system is reliant upon the Internet to supply users access to the music samples. Users must have access to the Internet, either through

f

the Kaplan stations 10 or through a personal computer, to listen to the music samples. In contrast, Applicant's claimed invention relies upon a private network architecture, that is not generally accessible to the public, for disseminating the claimed information.

Second, Kaplan nowhere discloses providing one or more databases that receive content providers' files, said databases including digitized and cataloged product information and at least one of sponsor information and attract videos as required by amended independent claim 1. Rather, Kaplan discloses that music samples are stored on CD's, not in a database (Kaplan, col. 12 lines 48-51). Also, Kaplan nowhere discloses databases of at least one of sponsor information and attract videos.

Third, Kaplan nowhere discloses a database that receives the content providers' files as required by amended independent claim 1. In fact, Kaplan is silent as to this aspect of Applicant's claimed invention. The Examiner states that Kaplan "must somehow receive the music files from the respective content providers" (Office Action, p.4, para. 5, lines 8-9). "Must somehow" does not meet the "necessarily flows" standard as set forth in *Ex parte Levy*.

Fourth, Kaplan nowhere discloses creating designated files for distribution to one or more end clients by combining into a single file the content providers' files, including said digitized and cataloged product information and said at least one of sponsor information and attract videos, and at least one attribute assigned for each content provider file as required by amended independent claim 1. Rather, Kaplan discloses that music samples are stored on CD's, not in designated files (Kaplan, col. 12 lines 48-51). The music samples of Kaplan do not contain digitized and cataloged product information, nor do they contain at least one of sponsor information and attract videos. Likewise, the music samples of Kaplan do not contain at least one attribute assigned for each content provider file. In contrast, the designated files of Applicant's invention contain all of this information.

In summary, for at least the reasons presented above, Kaplan does not disclose or suggest a method of disseminating information over a private network concerning a product as recited, having databases that receive content providers' files including digitized and cataloged product information and at least one of sponsor information and attract videos, and designated files

f

created that include at least one attribute assigned for each content provider file as required by amended independent claim 1. Accordingly, Applicant respectfully submits that amended independent claim 1 is allowable over the art of record.

Non-amended claims 2-6 and 23 all ultimately depend from amended independent claim 1. The allowability of dependent claims 2-6 and 23 thus follows from the allowability of amended independent claim 1; as such, dependent claims 2-6 and 23 are allowable over the art of record.

Applicant's independent claim 10, as amended, recites a method of disseminating information over a private network concerning multiple products that includes:

- receiving content providers' files, the content providers' files including digitized and cataloged product information and at least one of sponsor information and attract videos;

- assigning at least one attribute for each content provider file and creating designated files for distribution to end clients by combining into a single file the content providers' files, including said digitized and cataloged product information and said at least one of sponsor information and attract videos, and said at least one attribute for each content provider file;

- creating a database containing said designated files;

- selecting a plurality of end clients;

- transmitting said designated files to said selected end clients with each of said selected end clients receiving only its designated files, wherein said selected end clients are remotely disposed with respect to said database, with subsets of said selected end clients corresponding to differing products, including transmitting information corresponding to a first of said multiple products to a first subset of said end clients;

- providing a perceivable stimulus, from said information corresponding to said first of said products, to a consumer positioned proximate to said one of said end clients, with said perceivable stimulus being associated with said first of said multiple products; and

- wherein an interactive consumer stimulus initiated by said consumer includes said perceivable stimulus.

Kaplan neither discloses nor suggests a method of disseminating information over a private network concerning multiple products as recited, having content providers' files including digitized and cataloged product information and at least one of sponsor information

f

and attract videos, assigning at least one attribute for each content provider file, creating designated files for distribution to end clients by combining into a single file the content providers' files, transmitting the designated files to selected end clients where each of the selected end clients receives only its designated files and subsets of the selected end clients correspond to differing products as required by amended independent claim 10.

In asserting anticipation of the invention as claimed in independent claim 10, the Examiner refers to Figures 2 and 35-57 of Kaplan. Figure 2 of Kaplan illustrates the delivery of an audio or video sample over the Internet using Point-of-Preview and Point-of-Sale stations that receive the audio or video samples from compact discs over the Internet. Figures 35-57 illustrate Internet browser screen-shots of the system shown in Figure 2. Kaplan does not disclose or suggest the subject matter of amended independent claim 10 for at least the following reasons.

First, Kaplan nowhere discloses a method of disseminating information over a private network as required by amended independent claim 10. Rather, Kaplan discloses providing music samples over the publicly accessible Internet. The Kaplan system is reliant upon the Internet to supply users access to the music samples. Users must have access to the Internet, either through the Kaplan stations 10 or through a personal computer, to listen to the music samples. In contrast, Applicant's claimed invention relies upon a private network architecture, that is not generally accessible to the public, for disseminating the claimed information.

Second, Kaplan nowhere discloses receiving content providers' files including digitized and cataloged product information and at least one of sponsor information and attract videos as required by amended independent claim 10. In fact, Kaplan is silent as to this aspect of Applicant's claimed invention. The Examiner states that Kaplan "must somehow receive the music files from the respective content providers" (Office Action, p.4, para. 5, lines 8-9). "Must somehow" does not meet the "necessarily flows" standard as set forth in *Ex parte Levy*. Also, Kaplan nowhere discloses content providers' files including digitized and cataloged product information and at least one of sponsor information and attract videos.

Third, Kaplan nowhere discloses assigning at least one attribute for each content provider file as required by amended independent claim 10. Rather, Kaplan incorporates "the product

f

code established by the manufacturer or distributor" (Kaplan, col. 12 lines 54-55). In contrast, the present invention assigns the at least one attribute to the file after receipt from the content provider.

Fourth, Kaplan nowhere discloses creating designated files for distribution to one or more end clients by combining into a single file the content providers' files, including said digitized and cataloged product information and said at least one of sponsor information and attract videos, and at least one attribute assigned for each content provider file as required by amended independent claim 10. Rather, Kaplan discloses that music samples are stored on CD's, not in designated files (Kaplan, col. 12 lines 48-51). The music samples of Kaplan do not contain digitized and cataloged product information, nor do they contain at least one of sponsor information and attract videos. Likewise, the music samples of Kaplan do not contain at least one attribute assigned for each content provider file. In contrast, the designated files of Applicant's invention contain all of this information.

Fifth, Kaplan nowhere discloses transmitting the designated files to selected end clients where each of the selected end clients receives only its designated files and subsets of the selected end clients correspond to differing products as required by amended independent claim 10. Rather, Kaplan discloses stations (Kaplan, Fig. 1 and Fig. 2), each of which receive music samples relating to the product of retail music, not differing products, such as household goods, toys, toiletries, or clothing. In contrast, selected end clients of the present invention receive only their designated files relating to such differing products.

In summary, for at least the reasons presented above, Kaplan does not disclose or suggest a method of disseminating information over a private network concerning multiple products as recited, having content providers' files including digitized and cataloged product information and at least one of sponsor information and attract videos, assigning at least one attribute for each content provider file, creating designated files for distribution to end clients by combining into a single file the content providers' files, transmitting the designated files to selected end clients where each of the selected end clients receives only its designated files and subsets of the selected end clients correspond to differing products as required by amended independent claim 10. Accordingly, Applicant respectfully submits that amended independent claim 10 is allowable

f

over the art of record.

Non-amended claims 11-13 and 26 all ultimately depend from amended independent claim 10. The allowability of dependent claims 11-13 and 26 thus follows from the allowability of amended independent claim 10; as such, dependent claims 11-13 and 26 are allowable over the art of record.

***Claim Rejections under 35 U.S.C. §103(a)***

Claims 7, 14 and 24 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kaplan. Applicant respectfully traverses the rejections of claims 7, 14 and 24.

A §103(a), or obviousness, rejection is proper only when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art to which the subject matter pertains." 35 U.S.C. §103(a). The Examiner must make out a *prima facie* case for obviousness. The *en banc* Federal Circuit has held that "structural similarity between claimed and prior art subject matter, proved by combining references or otherwise, where the prior art gives reason or motivation to make the claimed compositions, creates a *prima facie* case of obviousness." *In re Dillon*, 16 U.S.P.Q. 2d 1897, 1901 (CAFC 1990). The underlying inquiries into the validity of an obvious rejection are: "(1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness." *In re Dembiczak*, 175 F.3d 994, 998, (Fed. Cir. 1999). For the reasons stated below, Applicant asserts that one of ordinary skill in the art would not have considered the invention obvious at the time of invention and, therefore, that Applicant's rejected claims 7, 14 and 24 are not obvious over the prior art of record.

With hindsight, a claim of obviousness can be an easy one to make. Many inventions seem obvious with the clarity of 20-20 hindsight. However, a hindsight basis for obviousness is inappropriate and cannot sustain a *prima facie* case of obviousness. Applicant respectfully asserts that the Examiner is judging obviousness of Applicant's invention using hindsight, and as such, should reconsider the rejections from the proper perspective of the time of Applicant's

F

invention, without the teachings of Applicant's disclosure. With this perspective in mind and for at least the reasons set forth below, Applicant requests withdrawal of the rejections.

Non-amended claims 7, 14 and 24 all ultimately depend from either amended independent claim 1 or amended independent claim 10. The allowability of dependent claims 7, 14 and 24 thus follows from the allowability of amended independent claims 1 and 10; as such, dependent claims 7, 14 and 24 are allowable over the art of record.

### **Conclusion**

In view of the foregoing, the claims are believed to be in form for allowance, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached Appendix is captioned "Version with markings to show changes made".

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition of allowance and a Notice to that effect is earnestly solicited.

**CHARGE STATEMENT:** The Commissioner is hereby authorized to charge fees that may be required relative to this application, or credit any overpayment, to our Account 03-3975/Order No. 044191-0300051 (PRN-010).

Respectfully submitted,  
Intellectual Property Group of  
PILLSBURY WINTHROP LLP

By 

Ross L. Franks  
Reg. No. 47,238

1600 Tysons Boulevard  
McLean, Virginia 22102  
Tel. No.: (650) 233-4897  
Fax No.: (650) 233-4545

60295224